

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 020375-002710US	
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on <u>April 9, 2007</u> .  TOWNSEND and TOWNSEND and CREW LLP  By: <u>/Janet L. Newmaker/</u> Janet L. Newmaker		Application Number 09/991,379	Filed November 15, 2001
		First Named Inventor John Joseph Mascavage III	
		Art Unit 3692	Examiner Siegfried E. Chencinski
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).          Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,358</u>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____		<u>/Irvin E. Branch/</u> _____ Signature <u>Irvin E. Branch</u> _____ Typed or printed name  <u>303-571-4000</u> _____ Telephone number  <u>April 9, 2007</u> _____ Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

☒ \*Total of 1 form is submitted.

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PATENT  
Attorney Docket No.: 020375-002710US

TOWNSEND and TOWNSEND and CREW LLP

By: /Janet L. Newmaker/  
Janet L. Newmaker

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

John Joseph Mascavage et al.

Application No.: 09/991,379

Filed: November 15, 2001

For: Online Purchasing Method

Customer No.: 20350

Confirmation No.: 2669

Examiner: Siegfried E. Chencinski

Art Unit: 3692

**PRE-APPEAL BRIEF**  
**REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection for the above-identified application. A response after final was filed on March 9, 2007. No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

## **REMARKS/ARGUMENTS**

Claims 1-7, 9-15 and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,899,980 to Wilf et al. (“Wilf”) in view of the cited portions of U.S. Patent No. 5,826,241 to Stein et al. (“Stein”), the cited portions of U.S. Patent Publication No. 2002/0055909 to Fung et al. (“Fung”), and Applicants’ Admitted Prior Art (“AAPA”).

Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilf, Stein, Fung and AAPA in view of the cited portions of U.S. Patent No. 5,920,847 to Kolling et al. (“Kolling”).

### **Claim Rejections Under 35 U.S.C. § 103(a)**

The Applicants respectfully request review of the final rejections of all claims. All pending claims stand rejected under 35 U.S.C. § 103(a). The Applicants believe that the rejections are improper because the final Office Action has not established a prima facie case of obviousness. The prior art does not teach or suggest all claim elements and the Office Action has not provided a motivation that one skilled in the art would be motivated to combine the references.

Focusing initially on claim 1, the second element recites “at a funds transaction server, receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount.” This element is not taught or suggested by the cited references. The final Office Action cites Wilf, col. 2, ll. 1-15 and 26-51, for this teaching. But Wilf does not teach that the transaction server receives the transaction information from the vendor site as claim 1 recites. Wilf teaches that a transaction server receives transaction details from the customer computer station (see col. 2, ll. 28-30). Hence, the cited references do not teach or suggest this element and claim 1 is believed to be allowable, at least for this reason. Claim 10 includes a similar element and is believed to be allowable for a similar reason.

Claim 1 also recites “opening a pop-up window for the customer.” Wilf also does not teach this, as correctly pointed out by the Office Action (p. 3). The final Office Action states that Wilf discloses the equivalent of opening a pop-up window and appears to rely on col. 2, ll. 3-5 and 47-51, for teaching an “equivalent” of a pop-up window. The Applicants, however, are unable to locate an “equivalent” of a pop-up window at that location or anywhere else in Wilf. Moreover, the final Office Action appears to rely on Fung for this teaching, but Fung is not available as prior art for this teaching since the Applicants’ parent application, which pre-dates Fung, teaches pop-up windows (see page 20, l. 19), contrary to the statement in the final Office Action that the parent application does not teach this (pp. 3-4). Hence, Fung is not prior art with respect to this teaching and the cited references do not teach or suggest opening a pop-up window for the customer. Claim 1 is, therefore, believed to be allowable for this additional reason. Claims 10 and 17 include a similar element and are believed to be allowable for a similar reason.

Claim 1 also recites “from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount.” The Office Action appears to reject this limitation in view of Wilf, Fung, and AAPA. But, as demonstrated above, Fung is not available as a prior art reference for the teaching of a pop-up window since the priority date of the parent application predates Fung and the parent application teaches a pop-up window. And, no reference teaches interacting with a pop-up window as recited in the claim. The Applicants are confused as to how the Applicants’ alleged admissions preserve Fung as a reference and the Applicants also reject the Examiner’s mischaracterization of the Applicants’ admissions. The point is moot, however, in light of the inapplicability of Fung as a reference for the teaching of a pop-up window in light of the mistake in the final Office Action, namely, that the parent application does not teach a pop-up window, which it clearly does. Hence, claim 1 is believed to be allowable for this additional reason. Claims 10 and 17 include a similar element and are believed to be allowable for a similar reason.

The remaining claims depend from one of the independent claims discussed above and are believed to be allowable , at least for the reasons stated above.

All pending claims are also believed to be allowable for the additional reason that the final Office Action has not provided a valid motivation that existed in the prior art to combine the reference teachings to make the Applicants' claimed invention. To be valid, the motivation must have some relevance as to why the references are combined and not merely to the subject matter of the references. The final Office Action relies on Wilf, col. 1, ll. 24-27, for the motivation to combine the references. At that location, Wilf refers to a "great reluctance of the users to transmit credit card information over the Internet" due to security reasons. But this motivation is irrelevant to the particular combination of references relied on by the final Office Action. What Wilf lacks of the Applicants' claimed invention is not provided by the other cited references for the purpose of overcoming this "great reluctance." For example, as correctly stated in the final Office Action, Wilf does not teach presenting the transfer amount through an Internet interface. The final Office Action relies on Stein for this teaching. But the reluctance of users to provide credit card information over the Internet is irrelevant to presenting the transfer amount through an Internet interface. Likewise, Wilf does not disclose opening a pop-up window for the customer, and the motivation is also irrelevant with adding this feature to the teachings of Wilf. The final Office Action appears to be using hindsight reasoning provided by the Applicants' disclosure to justify the combination. Hence, because the motivation relied on by the final Office Action is irrelevant to the claim elements missing from Wilf, the final Office Action has not established a prima facie case of obviousness with respect to any pending claim. All pending claims are, therefore, believed to be allowable for this additional reason.

Claims 12 and 13 are believed to be allowable for the additional reason that the final Office Action does not cite a reference in the prior art for the claim elements. The final Office Action states that the limitations are "implicit." This appears to be an argument for application of the doctrine of inherency for the missing limitations since a valid rejection cannot be maintained based on a claim element being "implicit" in a reference. All limitations must be expressly or inherently in the prior art reference. The limitations of claims 12 and 13 are not expressly in the cited references. Giving the benefit of the doubt that the Examiner intended to state that the limitations are inherent, the Applicants point out that the doctrine of inherency is only applicable when a missing limitation is necessarily present in a cited reference. That is not

the case for either claim 12 or claim 13. With respect to claim 12, all pop-up windows do not necessarily overlay an existing web browser window. For example, the existing window may not occupy the entire screen, in which case, the pop-up may overlay a portion of the screen not occupied by the existing window. Further, some pop-up windows may position themselves behind an existing window, becoming visible only after the user closes the existing window. Hence, the limitation of claim 12 is not necessarily present in the teachings of the cited references. Likewise, not all pop-ups are triggered by receiving transaction information as recited in claim 13. Pop-ups may be triggered by any of a number of events other than receiving transaction information. Hence, the limitation of claim 13 is not necessarily present in the cited references and claims 12 and 13 are believed to be allowable for this additional reason.

The Advisory Action mailed on March 26, 2007, did not address the substance of the Applicants' arguments presented in response to the final Office Action. Hence, those arguments are submitted for consideration herein.

## **Conclusion**

In view of the foregoing, Applicants respectfully request withdrawal of the rejections and issuance of a formal Notice of Allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: April 9, 2007

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